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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,073	05/19/2006	Bogumil Milkowski	341261-00004	9590
26304 7590 01/11/2010 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
HICKS, ROBERT J				
ART UNIT		PAPER NUMBER		
3781				
MAIL DATE		DELIVERY MODE		
01/11/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,073

Applicant(s)

MILKOWSKI ET AL.

Examiner

ROBERT J. HICKS

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Because of the applicant's amendment, the original objections to the specification, in the office action filed June 2, 2009, are hereby withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 21 and 22, the phrase "a ring-like one sided thickening" [Claims 21 and 22, Line 2] renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "a ring-like one sided thickening"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). It is uncertain from the claim if the thickening is ring-shaped, has a ring structure, is curved like a ring, or is a ring placed along the rim of the flange.

In addition, claim 22 is a duplicate of claim 21. See MPEP § 2173.05(n), 37 CFR § 1.75(b), and *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963). Claim 22 should be cancelled.

Claim Rejections - 35 USC § 102

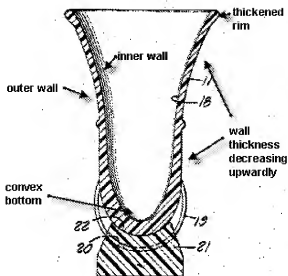
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bright (3,705,660).

Regarding Claim 17, the patent to Bright – a molded drinking container – discloses a preform of a plastic container [10, Fig. 3, Col. 2 Lines 3-8], comprising: a conically-shaped container [11] comprising a body having an inner wall and an outer wall defining a predetermined wall thickness [Fig. 3], said body having a bottom portion and a top portion, wherein the container body flares continuously outward from the bottom portion to the top portion [Fig. 3, Col. 2 Lines 23-27], wherein the degree in which the inner wall flares continuously outward is greater than the degree in which the outer wall flares continuously outward [Fig. 3], resulting in a wall thickness that gradually decreases starting from the bottom portion to the top portion [Fig. 3]; said bottom portion comprising a convex hemispherical shape; and said top portion comprising a cylindrical neck that includes a flange terminated in a thickened rim [Fig. 3].



Regarding Claim 23, Bright discloses the container body is plastic [Fig. 3, Col. 2 Lines 3-8]. See also MPEP § 608.02(IX) for the drawing cross-section for plastic.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

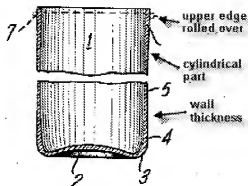
7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright as applied to claim 17 above in view of Yoshikawa (3,785,311) and further in view of Britton (6,413,467).

Regarding Claim 18, Bright discloses all the limitations substantially as claimed, as applied to claim 17 above. Bright does not expressly disclose the features of claim 18; however, the patent to Yoshikawa - a container with a thickened upper rim – discloses a container with a flange [Yoshikawa, 7] having a flange end with a thickness less than 0.3 mm [Yoshikawa, Col. 4 Lines 18-25], and the wall thickness is less than or equal to the cylindrical wall thickness [Yoshikawa, Col. 3 Lines 60-65]. The flange is located at the top of the cylindrical wall, and can be dimensioned to the user's needs. It would have been obvious at the time of the invention to one of ordinary skill, with market forces or other incentives driving one of ordinary skill to modify the prior art, to manufacture the Bright container preform to have a rim with a thickness of less than 0.3 mm and to have the wall thickness less than or equal to the that of the cylindrical wall portion, as suggested by Yoshikawa, for "the other part than the upper edge of said can having an extremely thin thickness so as to curtail the amount of material to be used for the can" [Yoshikawa, Col. 2 Lines 22-25], and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

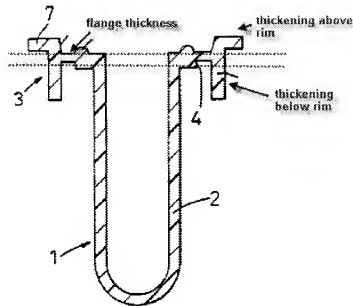


Although the Bright and Yoshikawa combination does not expressly disclose that the dimensioning of the thickness of the flange end and cylindrical wall is for plastics, the patent to Britton – a preform for a container – discloses that the preform used [Britton, 1] can be formed with a wall thickness and flange end thickness [Britton, 2, 6, and 7, Fig. 1] whether the preform is made of metal or plastic [Britton, Col. 3 Lines 7-12]. The method of forming the preform can be used with different materials. It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to manufacture and dimension the flange end and the wall thickness of the Bright and Yoshikawa combination using plastic material, as suggested by Britton, to manufacture the preform easily [Britton, Col. 1 Lines 16-17 and 34-41].

Regarding Claim 19, Bright in view of Yoshikawa in view of Britton discloses all the limitations substantially as claimed, as applied to claim 18 above; further, Yoshikawa teaches the thickness of the flange is less than 0.3 mm [Yoshikawa, Col. 4 Lines 22-25].

9. Claims 20-22 are 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright as applied to claim 17 above in view of Britton.

Regarding Claims 20-22, Bright discloses all the limitations substantially as claimed, as applied to claim 17 above. Bright does not expressly disclose the features of claims 20-22; however, the patent to Britton discloses a preform [Britton, 1] in which the rim [Britton, 3] has an annular thickening on top [Britton, 7], and underneath [Britton, 6] the rim, and in which the height of the thickenings range from 1.1 to 2.0 times the flange thickness [Britton, 4, Fig. 1]. The thicknesses on the top and bottom of the preform show rings that are attached to the flange, and which have heights that are more than the height of the flange. It would have been obvious at the time of the invention to one of ordinary skill, with market forces or other incentives driving one of ordinary skill to modify the prior art, to manufacture the thickening portions on the rim of the Bright preform to be larger than the flange thickness, as suggested by Britton, to be able to locate the container during manufacturing [Britton, Col. 1 Line 66 to Col. 2 Line 1], and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).



Regarding Claim 24, Bright discloses all the limitations substantially as claimed, as applied to claim 17 above. Bright does not expressly disclose that the container is made from polyethylene terephthalate (PET); however, the patent to Britton discloses the preform [Britton, 1] is made from PET [Britton, Col. 3 Lines 7-12]. The preform can be made of various materials. It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to manufacture the Bright container preform from PET, as suggested by Britton, to manufacture the preform easily [Britton, Col. 1 Lines 16-17 and 34-41].

Response to Arguments

10. Applicant's arguments with respect to claim 17 have been considered but are moot in view of the new ground(s) of rejection.

11. In response to applicant's argument that the Bergholtz (6,260,723) reference fails to show certain features of applicant's invention regarding claim 17 {**Remarks**, Page 5 Lines 20-25}, see Paragraph 5 of this office action to see how Bright meets the claim limitations regarding claim 17.

12. In response to applicant's argument that the Bergholtz, Yoshikawa, and Britton references fail to show certain features of applicant's invention {**Remarks**, Page 6 Lines 18-21}, Yoshikawa teaches the dimensions of the flange and wall thicknesses [**Yoshikawa**, Col. 3 Lines 60-65 and Col. 4 Lines 18-25], and Britton teaches the flange and wall thicknesses can be dimensioned for metal or plastic performs [**Britton**, Col. 3 Lines 7-12].

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. HICKS whose telephone number is (571)270-1893. The examiner can normally be reached on Monday-Friday, 8:30 AM - 5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert J Hicks/
Examiner, Art Unit 3781

/Anthony Stashick/
Supervisory Patent Examiner, Art
Unit 3781

